

REMARKS

Claims 1-30 were pending in the present application. New claim 31 has been added. Reconsideration of the application is respectfully requested in view of the following responsive remarks. Specifically, in the Office Action of February 27, 2006, the Examiner rejected claims 1-30 under 35 U.S.C. 103(a) as being unpatentable over JP 2003286687 (JP 687) and U.S. Patent No. 5,614,325 (hereinafter "Chartier").

It is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every amendment herein is fully supported by the specification as originally filed, and that no new matter has been added.

Rejections Under 35 U.S.C. § 103

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. Further, the Examiner has to establish some motivation or suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

JP 687 teaches of a mat coated paper that can include two coated layers on each side of a paper substrate. The undercoat contains wet heavy calcium carbonate and adhesive, and the finish coat contains pigment (dry milled calcium carbonate and hollow synthetic resin pigments) and adhesives. It is clear from reviewing the specification as a whole that this paper is specifically prepared for ink application, as it mentions offset printing in paragraph [0005] and all of the Examples discuss 4 color printing with ink. There is no mention of electrophotographic printing in JP 687.

Chartier does describe electrophotographic coated print media, but only describes single layer coatings (on both sides).

As a first point, it is noted that claims 1 and 24 both require that there be base stock, two base coating layers (one on each side), and two receiving layers (one on each side). These claims also require that the base coating layers be different than the receiving layers. In other words, the claimed media sheets must include at least five (5) layers, where base coating layers are different than receiving layers.

Regarding JP 687, as this is a paper for printing inks, there would be no motivation to one skilled in the art to add a charge control agent. As the Examiner is aware, there must be some teaching or suggestion in the prior art to modify a cited reference to arrive at the claimed invention, or to suggest combining that reference with a secondary reference. That motivation must come from the reference itself. As media for printing ink does not require a charge control agent nor would it even benefit from such an additive, there would be no motivation to modify the media to include such an agent.

Conversely, Chartier teaches of an electrophotographic media that includes a base sheet and a single coating on both sides of the substrate, i.e., three layers. Claims 1 and 24 have been amended to clarify that the base coating layers are different than the receiving layers (thus requiring five distinct layers – 1 base stock layer, 2 base coating layers, and 2 receiving layers), further distinguishing this claim from Chartier. Additionally, it is noted that Chartier does not include any discussion of hollow particles. Thus, there does not appear to be any teaching or suggestion to modify this reference by combining it with the teachings of JP 687. Further, there is no suggestion in Chartier that its paper can even be modified to be an ink receiving media, which is the focus of JP 687.

The Applicant recognizes that it is the combination of the two references that the Examiner is using to arrive at the claimed invention and not either reference individually. The above discussion is provided to show why the two references are not believed to be properly combinable, and why one skilled in the art would not look to Chartier to modify the teachings of an ink receiving media, as they are in different printing fields. Reconsideration of this rejection on these grounds is respectfully requested.

As an additional matter, it is noted that claim 31 has been added to explicitly claim an embodiment that is broadly covered by claim 1 and specifically supported in the specification. Specifically, claim 31 is drawn to embodiments where there is no

binder present in the receiving layers (which JP 687 specifically requires), other than the natural binding properties provided by the hollow particles and other non-binder ingredients. Support for this amendment can be found throughout the specification, particularly where the binder is described as being optional in the receiving layer. Neither reference teaches applying any type of coating without a binder or adhesive. Thus, this claim should be allowed over the combination cited by the Examiner for independent reasons than those discussed above with respect to claims 1 and 24.

In view of the foregoing, Applicants believe that claims 1-31 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 27th day of April, 2006.

Respectfully submitted,



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